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TECH CENTER 1600/2900 PATENT
Attorney Docket No. 3495.0111-11
Customer Number: 22,852

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Bernard DUJON et al.

Serial Number: 09/492,697

Filed: January 27, 2000

Group Art Unit: 1633

Examiner: KAUSHAL, S.

For: NUCLEOTIDE SEQUENCE ENCODING
THE ENZYME I-SCEI AND THE USES THEREOF

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Assistant Commissioner for Patents
Washington, D.C. 20231

OFFICE OF PETITIONS
DEPUTY A/C PATENTS

Sir:

RESPONSE TO PAPER NO. 14

In response to the Office Action dated June 20, 2001 (Paper No. 14), applicants submit the following remarks.

REMARKS

Reconsideration of this application is respectfully requested. Claims 38-60 are pending in this application.

Claims 45-48, 50, 51-55, and 57-60 were objected to for encompassing non-elected subject matter. Applicants traverse this objection.

Applicants are unaware of, and the Examiner has not provided, any legal basis for the Examiner's objection. The mere fact that applicants' generic claims encompass non-elected subject matter is an insufficient basis to object to applicants' claims. All generic claims, by definition, encompass non-elected subject matter. If the Examiner's objection were correct, it would be impossible for applicants to obtain generic claims.

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This is improper. Consequently, this objection is improper and should properly be withdrawn.

All of applicants' claims are generic claims that read on the elected species. As stated in M.P.E.P. § 809.02(c): **"An examiner's action subsequent to an election of species should include a complete action on the merits of all claims readable on the elected species."** Therefore, the Examiner should completely examine all pending claims.

No rejection of any of claims 45-60 has been made by the Examiner. As stated in M.P.E.P. § 707.07(d): "Where a claim is refused for any reason relating to the merits thereof it should be 'rejected' and the ground of rejection fully and clearly stated, and **the word 'reject' must be used.** The examiner should designate the statutory basis for any ground of rejection by express reference to a section of 35 U.S.C. in the opening sentence of each ground of rejection." The requisite term "reject" has not been used in the Action. Furthermore, no reference to any statutory basis for a rejection can be found in the Office Action.¹ Therefore, claims 45-60 are allowable.

Claims 45-48, 50-55, and 57-60 were withdrawn from consideration as allegedly being drawn to a non-elected invention, there being no allowable generic or linking claim. (Paper No. 14 at 3.) Applicants disagree.

¹ According to the face page of Paper 14, no claims are rejected. Furthermore, the Examiner's comments on page 4 of the Action are insufficient to constitute a rejection since no specific claims are referenced and the term "reject" was not used.

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As discussed above, there is **no** rejection of claims 45-48, 50-55, and 57-60 and the objection to these claims is improper. The Examiner's reason that there is no allowable generic claim (Paper No. 14 at 4) is not supported by any rejection or statutory basis. Therefore, the withdrawal of these claims from examination is improper.²

Applicants respectfully submit that the application is in condition for allowance, and respectfully request issuance of a notice of allowance. If the Examiner should disagree, he is invited to contact the undersigned to discuss any remaining issues.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER L.L.P.

By: _____

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Dated: November 19, 2001

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² Even assuming that there were no allowable generic claim, it would not be proper to withdraw claims 38-47, 50-54, and 57-60 from consideration. Claims 38-47, 50-54, and 57-60 all read on the elected species. It would only be proper to withdraw claims **not** readable on the elected species. (See M.P.E.P. § 802(c)(A).)